

REMARKS

Claims 1-12, 15-28, and 31-39 were pending in the application. Claims 7-10, 23-26, and 34-39 have been withdrawn from consideration. In this amendment, Claims 1, 3, 17, 19, 20, and 33 have been amended and new Claims 40 and 41 have been added. Therefore, Claims 1-12, 15-28, and 31-41 are pending in the application. Claims 7-10, 23-26, and 34-39 have been withdrawn from consideration.

The Rejections under 35 U.S.C. § 112

The Examiner has rejected Claims 1-6, 11-20, 21, 22, 27, 28, and 31-33 under 35 U.S.C. 112 as being indefinite. As Claims 13 and 14 had been previously canceled, it is respectfully submitted that the present rejection is moot with regard to those claims. For the remaining claims, the Examiner noted that an element listed as hanging means in claims 1 and 17 is not a structural element. Applicant has amended Claims 1 and 17 to remove the offending element.

The Rejections under 35 U.S.C. § 103

The Examiner has rejected Claims 1-6, 11, 12, 15-22, 27, 28, and 31-33 under 35 U.S.C. 103(a) as being unpatentable over Atsumi (JP 2004129629A) in view of Reed (U.S. 6,655,083). Applicant respectfully traverses the rejection.

The publication date of the Atsumi reference is more than two months after the filing date of the instant application. The Atsumi reference does not qualify as a valid reference under any section of 35 U.S.C. 102; therefore, it is not a valid reference under 35 U.S.C. 103. Accordingly, Applicant respectfully requests that the Atsumi reference be excluded. Furthermore, since, as described above, the Atsumi reference should be disqualified; there is no teaching to modify as described by the Reed patent.

To establish a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation, either in the references themselves or in a convincing line of reasoning with knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See Manual of Patent Examining Procedure (MPEP) §2144; *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985). There is no suggestion to combine the references.

As for Claim 1, Applicant respectfully suggests that it does not make sense to combine the references. First, the combination of Atsumi and Reed causes their primary functionality to be diminished or obliterated. The receptacle of the present invention is adapted to be mounted to

a railing. The hanging means would have no utility with respect to the in-ground planter receptacle as shown by Atsumi (Figures 7 & 8). The hanging means would detract from Atsumi's ability to provide support and structural reinforcement for above ground planter receptacle applications (Figures 9 thru 11). Indeed, attachment by hanging means would only place additional stress on guardrail and rail type fence structures.

Additionally, the swing of Reed would not function if it were hung from a baluster railing or picket fence along the edge of a deck, porch, or patio, as described in the present application. A top rail is generally too low to provide a satisfactory height for a swing, and the balusters, pickets, and deck or porch would interfere with the back and forth motion of the swing. Accordingly, the primary functions of Atsumi and Reed causes their very combination to be illogical and abstract, and not at all obvious.

Second, Applicant's invention and Atsumi teach solutions for fundamentally different applications. The present invention teaches a hanging means for variable positioning of the planter receptacle on baluster or picket-type railings, as described in the specification. As correctly noted by the Examiner, Atsumi lacks hanging means. This is precisely because Atsumi provides a stationary solution appropriate to rail type or roadside guardrail type fencing (see Figures 7 thru 11). For Atsumi, there is no need to further secure its planter receptacle with a tether similar to the present invention, as its planter receptacle is stationary to best support rail type fencing structures, and/or reinforce guardrail fencing. Any tether would be pointless and may involve increased danger to persons or property should such fencing be impacted by passing objects.

Third, Applicant's invention and Reed show solutions for fundamentally different applications. Again, the present invention teaches a hanging means for positioning planter receptacles on baluster railings and picket fencing at a variable height, as described in the specification. While Reed too shows hanging means, it exists solely to provide functionality for the swing, not the planter receptacle of Reed. Indeed, prolonged swinging action would only disturb the plants and/or soil contained in the receptacle integrated into the swing seat, thereby diminishing the planter's "growing" functionality.

For these reasons, making the association to combine Atsumi and Reed in order to compare them to Applicant's invention seems to be abstract and illogical. The purposes of

Atsumi and Reed are not at all similar to the purpose of the present application. As Atsumi in combination with Reed neither teaches nor suggest the features of the present invention, Claim 1 is patentably distinguished.

Claim 2 depends from Claim 1 and incorporates the same limitations as Claim 1. Thus, Claims 2 is patentably distinguished.

As for Claims 3 and 4, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention with respect to stabilization. Stabilization here is contrasted with attachment. Atsumi teaches the creation of walls that are or become part of a guardrail, and which are attached to the guardrail support posts, thereby preventing ready adjustment with respect to the planter receptacle. Similarly, as explained previously, Reed teaches attachment to the swing seat. Only Applicant's invention teaches true stabilization, that is, avoiding fixed (stationary) attachment with respect to its planter receptacle walls in order to preserve nearly effortless adjustability with respect to its railing.

Furthermore, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of the present invention whereby stabilization is achieved by relying on the proximity of planter receptacle walls with respect to the baluster component(s) of the railing to reduce, but not completely prevent horizontal motion, and to fully permit vertical motion of the planter receptacle. Indeed, the Examiner has correctly noted that "Atsumi as modified by Reed lacks the support being a baluster." Again, Atsumi makes no reference to baluster railings or picket fencing types, referencing rail type fencing and guardrail (expressway) types instead, and referencing fencing posts for support. Reed makes no reference to railings or fencing whatsoever. Accordingly, Claims 3 and 4 are patentably distinguished.

Claims 5 and 6 depend from Claim 1 and incorporate the same limitations as Claim 1, which as described above, is patentably distinguished from the combination of references. Thus, Claims 5 and 6 are patentably distinguished.

As for Claims 11 and 12, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention comprising a mechanical system such as S-hook and chain, or stopped cable and retainer, to provide ready vertical adjustment of its planter receptacle. This provides a straightforward solution for accommodating the rapid growth of flowers during a relatively short growing season to improve viewing such flowers with respect to

deck/porch and patio railings. Atsumi instead relies on a fixed attaching system (refer to junction screw 19, and bolt nut 28), and Reed does not address adjustment, which is so seldom an issue for swings since people grow much more slowly over years and years than seasonal flowers. Consider too, that both Atsumi and Reed would require not only more time to achieve adjustment, but they would require tools as well. Applicant's invention does not require tools to achieve adjustment.

The combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby the connecting means itself is vertically adjustable to provide for precise leveling of the planter receptacle with respect to the railing or picket fence. This functionality is separate from, and in addition to, the vertical adjustability of the planter receptacle described immediately above. Neither Atsumi nor Reed teaches this feature.

Further, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby the planter receptacle is in a readily movable and adjustable position with respect to the railing to which it is attached or tethered. Atsumi teaches a stationary solution (again, refer to junction screw 19 and bolt nut 28, and the absence of any feature providing for ready adjustment with respect to its fencing or guard rail). Reed teaches a planter receptacle that is part of the swing seat ("integrally formed with said seating member"), not a receptacle that is movable with respect to the swing seat. The tether of Reed relates to the swing seat, not its planter receptacle. Thus, Claims 11 and 12 are patentably distinguished.

As for Claim 15, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby (a) attachment using hanging means is combined with (b) stabilization to achieve the desired utility with respect to the planter receptacle. As explained previously, Atsumi lacks hanging means, since it relies on a fixed attachment system. Stabilization means is therefore absent as taught by Atsumi as well, since it is unnecessary for a fixed attachment system. Reed lacks stabilization means, which is completely undesirable for a swing since it would restrict its back and forth motion. Thus, Claim 15 is patentably distinguished.

As for Claim 16, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby fast and easy height variability is achieved by

relying on the interoperability of the hanging means with the connecting means. Neither Atsumi nor Reed teaches any similar functionality. Thus, Claim 16 is patentably distinguished.

In addition to the invalidity of the Atsumi reference, as described above, Claims 1-6, 11, 12, 15, and 16 of Applicant's invention are patentably distinguished from the cited references. As for Claim 17, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby the planter receptacle is compatible with baluster railings or picket fencing. Atsumi teaches attachment to rail-type fencing and guardrail (expressway) fencing, instead. Reed teaches no attachment to railing or fencing of any type whatsoever. Again, a swing would not be functional if it were attached to a railing or fence.

Additionally, the combination of Atsumi and Reed, as cited by the Examiner does not teach the feature of Applicant's invention whereby the balusters of the railing or pickets of a picket fence are relied upon for stabilization, which is necessary for the tethered system. Neither Atsumi nor Reed teaches stabilization, or baluster reliance for stabilization.

Finally, the combination of Atsumi and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby the top rail is relied upon for attachment. Atsumi does not show attachment to the top rail disclosed in its Figures 7 thru 9, while Figure 10 shows attachment to fence posts together with top and bottom rail attachment to the same posts. Figure 11 shows a guardrail, which by its nature lacks a separate top rail. Reed shows no functionality with respect to railing or fencing whatsoever.

The remaining Claims 18-22, 27, 28, and 31-33 depend from Claim 17 and incorporate the same limitations as Claim 17, which as described above, is patentably distinguished from the combination of references. Thus, Claims 18-22, 27, 28, and 31-33 are patentably distinguished. Moreover, the same arguments with regard to Claims 2-6, 11, 12, 15, and 16 apply to Claims 18-22, 27, 28, and 31-33, respectively. Accordingly, Applicant respectfully asserts that all the claims are patentably distinguished.

The New Claims

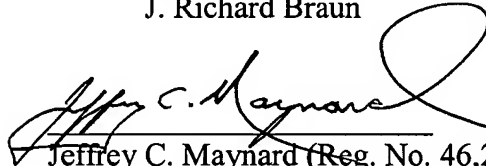
Applicant has added new dependent Claims 40 and 41 eliciting additional features of Applicant's invention. It is believed such claims are also allowable. For renumbering purposes, it is suggested that new Claim 40 should come immediately after Claim 16 and new Claim 41 should come immediately after Claim 33.

CONCLUSION

Applicant has made a diligent effort to address the rejections identified by the Examiner and respectfully submits that the outstanding rejections in the Office Action have been overcome. In view of the above amendments and remarks, all pending claims are believed to be patentable, and thus, the case is in condition for allowance. Accordingly, a Notice of Allowability is respectfully requested at the Examiner's earliest convenience. In the event that there is any question concerning this response, or the application in general, Applicant respectfully requests that the Examiner contact Applicant's attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,
J. Richard Braun

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Date


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